

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejections under 35 USC § 103

The rejection of claims 1, 4, 7 and 12-14 under 35 USC § 103(a) as being unpatentable over Fishbine et al. in view of Wakabayashi et al. and further in view of Fujieda et al., is respectfully traversed.

This rejection acknowledges on page 4, that Fishbine in view of Wakabayashi lacks a scanner which is a “swipe” scanner and cites Fujieda et al. to overcome this admitted shortcoming. However, the arrangement which is disclosed in Fig. 14 of Fujieda et al. is not a “swipe” scanner. The fact that the Fujieda et al. scanning arrangement has an internal moving part would not prompt the hypothetical person of ordinary skill to remotely consider this arrangement to be a “swipe” scanner.

A rejection made under 35 USC § 103 and must be founded on what the hypothetical person of ordinary skill would understand a reference to disclose and how this person would be motivated by this disclosure. The scanner embodiment shown in Fig. 14 is the same basic static scanner as all of the other embodiments disclosed in this reference which don't have a movable sensor unit 36 incorporated therein. However, it appears that, for the sake of rejection, because the movable sensor unit 36 moves in order to scan the image which is passing through the optical guide plate 23 (which forms part of the static scanner), this embodiment is erroneously considered to be a “swipe” scanner.

It is respectfully submitted that this is totally untenable and nothing short of incongruous. Similarly untenable is the notion that these teachings could be transferred to Fishbine in view of Wakabayashi in a manner which would result in this combination having a swipe scanning capacity.

It is submitted that the use of a movable sensor unit such as found in Fujieda et al. could conceivably be incorporated into the Fishbine arrangement – viz., incorporated into

the image recorder 18 of Fishbine - but the fingerprint scanner would remain basically unchanged and – as acknowledged in this rejection – not a swipe scanner.

This rejection is totally untenable for at least the above, and should be withdrawn.

The erroneous assumption that a moving part of a static scanner converts the static scanner into a swipe scanner is fatal flaw that permeates all of the rejections which are hereby summarily traversed on these grounds.

Double Patenting

The application of Fujieda et al. in this rejection has the same crippling effect. The rejection of claims 1, 4, 7, 12, 13 and 14 as being unpatentable over claim 4 of USP 6,633,332 to Nay et al. in view of Wakabayashi et al. and Fujieda et al. is either untenable or such as to render the rejection moot. More specifically:

Claims 1 and 4 of Nay et al. read:

1. A digital camera system, comprising:
 - a lens;
 - a conversion device configured to receive light from said lens and to define a first set of digital data based on said light;
 - a scanning mechanism configured to scan a document and to produce a second set of digital data, said second set of digital data defining an image of said document, said scanning mechanism comprising an imaging sensor and a processing device, said imaging sensor configured to receive light reflected from said document and to produce electrical signals, said processing device configured to receive said electrical signals from said imaging sensor and to define said second set of digital data based on said electrical signals from said imaging sensor;
 - a storage device; and
 - a system controller configured to store said first set of digital data and said second set of digital data into said storage device.
4. The system of claim 1, wherein said system controller is further configured to merge said first and second sets of digital data into a third set of digital data.

A successful transfer of teachings from Fujieda et al. would (arguendo) result in the swipe scanner of Nay et al. being converted to a static scanner with a moving part as distinct from a swipe scanner as recited in at least claim 1 of this application. The Examiner is reminded that that a static scanner with a moving part is not a swipe scanner. A successful transfer of teachings would defeat the rejection for at least this reason.

On the other hand, the position that Fujieda et al. disclose a finger print scanner that "swipes" across a finger to be imaged is, as pointed out above – untenable. The finger in Fujieda is sitting still on the scanner device – and neither the scanner proper nor the finger move. A movable sensor unit 36 within the scanner, scans an image which is coming through a stationary transparent member which forms part of the stationary or static scanner. The scanner as a whole does not move and is not a swipe scanner, internal moving part or no. Therefore, the continued application of Fujieda et al. defeats the chance of the rejection being held tenable.

Either way, the double patenting rejection fails.

As to the issue pertaining to the merging of the two sets of data, it is reiterated that there is neither disclosure nor suggestion of any "merging" of the first and second sets of data in the storage nor disclosure of the formation of a "third set of data" anywhere in the rejected claims. Why go to the bother of merging to sets of data if there is no motivation to do so?

The issue is not whether it could be done but why it would be done. The position that "it would become an obvious variant of the '332 patent", is not motivation.

A further shortcoming is that "inherency" is replied upon. That is to say, it is asserted that "when two sets of data are merged into a third set" "the two sets of data are *inherently* in association with each other."

For inherency to hold, it is necessary for the asserted inherent feature to occur each and every time and in every instance that sets of data are merged to form another set, and not just in some instances. It is not clear that every possible form of data merger would leave the two sets in a form that would be considered to be "in association with each other." "In association" would seem to imply some form of predetermined interrelationship and almost seem to infer some predetermined relationship such as that which would allow the two sets to be separated back into their original form.

Depending on the manner in which the data is merged, it may be blended and/or some (e.g. redundant data) selectively deleted, to the degree that a determination of which data came from which set may not be possible and that the new set of data which has its own unique "association," may be irreversibly formed. The two sets of data may be "in" the third set – like two glasses of water poured into a vase - but whether they remain "in association with each other" *per se* remains totally uncertain. The rejection contains nothing that would resolve these uncertainties and must therefore be considered untenable.

Conclusion

The rejections are untenable in that it is acknowledged that the combination of the Fishbine and Wakabayashi do not have a swipe scanner and the teachings of a movable part of a static scanning arrangement cannot be transferred in a manner which would produce a swipe scanner. A *prima facie* case of obviousness has not been established and the claims are therefore allowable over the art of record. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

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